

REMARKS

I. Status of the Claims

Upon entry of this Amendment, claims 1-9 and 12-117 are currently pending, with claims 25-78 and 108-117 being withdrawn as directed to non-elected subject matter pursuant to the Restriction Requirement dated December 14, 2006. Claims 10-11 are canceled without prejudice or disclaimer. Further without prejudice or disclaimer, claims 1, 5, 27, 29, 49-51, 59-60, 67, 74-75, 104, 107, 112, 114, 116, and 117 are amended herein. Exemplary support for these amendments can be found in the specification and original claims as-filed. *See, e.g., original claim 11.* Accordingly, there is no issue of written description.

II. Rejections under 35 U.S.C. § 112

A. Rejection under 35 U.S.C. § 112, first paragraph

The Office maintains the rejection of claims 1-10, 12-24, and 79-107 under 35 U.S.C. § 112, first paragraph, as allegedly "failing to comply with the written description requirement." Office Action, page 2. Specifically, the Office states that "the comparative testing [in the specification] is limited to one wax under the trade name Kester K 82P" and asserts that "one species tested for claim 1 composition is not representative of [the] genus." *Id.*, pages 6-7. The Office further alleges that "the teaching at paragraphs [0026] and [0036] is to one wax of formula (I)" and concludes that "**only the tacky wax having formula I [has been] shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first paragraph.**" *Id.*, pages 7-8 (emphasis original).

While Applicants disagree with the rejection, solely to expedite prosecution, Applicants have amended independent claims 1 and 104 to include formula (I) from claim 11. Each of claims 2-9, 12-24, 97-103, and 105-107 ultimately depend upon claims 1 or 104. Accordingly, these dependent claims encompass formula (I). Claims 10 and 11 were canceled.

Based on the Office's comments that "formula (I) . . . meet[s] the written description provision" and because claim 11 was not rejected, Applicants understand that, with the amendments herein, claims 1-9, 12-24, and 97-107 meet the written description requirement.

Accordingly, Applicants respectfully request withdrawal of the rejection.

B. Rejection under 35 U.S.C. § 112, second paragraph

The Office maintains the rejection of claim 107 under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite." Office Action, page 8. Specifically, the Office alleges that the "specification fails to describe the scope for 'care composition.'" *Id.*, page 9. The Office asserts, for example, that "[c]are compositions for skin means the composition is used for taking care of problems associated with the skin" and argues "[t]his can be treating wrinkles or treating pigmentation or dry skin or oily skin." *Id.*

While Applicants disagree with the rejection, solely to expedite prosecution, claim 107 has been amended herein to recite, in relevant part, "said composition is in a form of a makeup composition for keratin fibers." Applicants respectfully submit that "makeup composition" is definite. Further, because the Office has not objected to the term "makeup composition," Applicants understand this term to meet the requirements of 35 U.S.C. § 112, second paragraph.

Accordingly, Applicants respectfully request withdrawal of the rejection.

II. Rejection under 35 U.S.C. § 103(a)

The Office maintains the rejection of claims 1-24 and 79-107 under 35 U.S.C. § 103(a) as allegedly “being unpatentable over the combination of” U.S. Patent No. 5,985,298 to Brieva et al. (“Brieva”) and U.S. Patent No. 5,783,176 to Meiring et al. (“Meiring”). Office Action, page 9. Specifically, the Office states that Brieva “teaches waxes in cosmetic compositions and the weight percent is 0.1-30% wax...and example 2 teaches synthetic wax but not the synthetic bees wax since Kester wax taught by [the instant] specification as tacky wax...and [Meiring] teaches tacky wax claimed in instant application as an ester.” *Id.*, page 12 (emphasis original). The Office then alleges that “one of ordinary skill in the art would prepare compositions of [Brieva] and substitute bees wax or synthetic wax taught in the mascara composition of [Brieva] with tacky wax of [Meiring] expecting predictable results.” *Id.*

Additionally, the Office asserts that Meiring “teaches ester having the following formula in cosmetic formulation [referring to the general formula disclosed in Meiring and further asserting that] [t]here is overlap regarding variables [when comparing Meiring’s formula to the formula in instant claim 11].” *Id.*, page 13-14. The Office then questions about the value of n for the tacky wax in example 1 in the specification and argues “[t]he showing in the specification is not commensurate with the scope of the claims.” *Id.*, page 15. Applicants respectfully disagree and traverse for the reasons of record. However, by this Amendment, Applicants have amended, in relevant part, independent claims 1 and 104. To the extent, however, that the Office may consider rejecting amended independent claims 1 and 104 based on the rejection of record,

Applicants respectfully submits that the Office has failed to establish a *prima facie* case of obviousness with respect to the subject matter recited in amended independent claims 1 and 104.

Determining the obviousness of a claimed invention under 35 U.S.C. § 103 requires that the Office apply three factual inquiries. See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) (“...the [*Graham*] factors continue to define the inquiry that controls.”). Specifically, in order to establish a *prima facie* case of obviousness, the Office must objectively perform each of the following factual inquiries:

- (A) Ascertain the scope and contents of the prior art;
- (B) Ascertain the differences between the claimed invention and the prior art; and
- (C) Resolve the level of ordinary skill in the pertinent art.

See *Graham* 383 U.S. 1 at 17-18; see also M.P.E.P. § 2141(II). Further, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02(VI) (emphasis original) (citations omitted).

Applicants respectfully submit that the Office has not made a *prime facie* case of obviousness because the Office has not considered the references in their entirety including portions that lead away. The instant claims recite, in relevant part, “at least one wax in an amount of at least 27% by weight.” As discussed in the Response to Office Action filed January 26, 2009, Applicants acknowledge that Brieva broadly discloses compositions having 0.1-30% wax. However, Example 2 of Brieva, which the Office specifically cites, contains only 22.95% wax. The Office replies that “one cannot show nonobviousness by attacking references individually.” Office Action, page 12.

However, Applicants respectfully submit that they are not attacking the references individually, but are, in fact, showing that the combination of Brieva and Meiring teaches away from the instant claims.

For example, while Example 2 of Brieva contains 22.95% wax, Meiring states that the ester cited by the Office as a wax is “advantageously present in a content of 15-25% by weight.” See Brieva, Example 2; see also Meiring, col. 4, lines 31-43, and claim 3. Accordingly, considering both references, Applicants respectfully submit that one of ordinary skill in the art at the time of the invention would have been motivated to prepare a composition within Meiring’s range of 15-25%, especially given the Brieva’s example is within this range. Thus, the teachings of both documents, alone and especially in combination, teach away from compositions comprising “at least one wax in an amount of at least 27% by weight,” as claimed.

Further, with the amendments herein, claims 10-11 are canceled and independent claims 1 and 104 are amended to recite, in relevant part, “wherein the at least one wax comprises at least one compound of formula (I).” See, e.g., claim 1. The Office argues that Meiring “teaches an ester” whose formula “overlap[s]” with formula (I) of the present claims. Office Action, pages 13-14. The Office alleges that “one of ordinary skill in the art would prepare compositions of [Brieva] and substitute bees wax or synthetic wax taught [therein] with [the] tacky wax of [Meiring].” *Id.*, page 12. Applicants respectfully disagree.

The Supreme Court has held that the Office, must look at various teachings “all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed,” especially given the Court’s acknowledgement that

“claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR*, 127 S.Ct. at 1740-41 (emphasis added). In this case, the Office provides no reason why one of skill in the art at the time of the invention would have selected the specific compound(s) of formula (I), according to the instant claims, out of all the tacky waxes known in the art. Rather, the Office uses impermissible hindsight, simply arguing that the ester of Meiring and Brieva’s wax are “functional equivalents.” See Office Action, pages 10-11. However, the Office provides nothing to support this conclusion of “functional equivalents.”

Moreover, the instant application destroys a “functional equivalents” argument. In particular, comparative Example 2 contains beeswax (i.e., certain wax of Brieva) whereas inventive Example 1 contains a wax of the specific formula (I) as claimed (i.e., certain wax of Meiring). The results demonstrate that Example 1 has a better combination of physical properties (e.g., stability, viscosity, and consistency) compared with Example 2 (as well as four other compositions containing waxes falling outside the scope of the claims). See Specification as-filed at ¶¶[0184]-[0193]. Accordingly, the different results show that these waxes are not “functional equivalents” as the Office alleges.

Further, a reasonable expectation of success is required to support a conclusion of obviousness. See M.P.E.P. § 2143.02. In order to have a reasonable expectation of success, at least some degree of predictability is required. M.P.E.P. § 2143.02(II). In the Response to Office Action filed January 26, 2009, Applicants noted that the comparative testing presented in the instant specification shows the unpredictability when employing different waxes. The Office argued that “the showing in the

specification is not commensurate with the scope of the claims." Office Action, page 15 (emphasis original). However, the Office fails to appreciate that Applicants are not arguing unexpected results to rebut a *prima facie* of obviousness. Rather, Applicants present the evidence to show there is no *prima facie* case of obviousness because there is no reasonable expectation due to the unpredictability.

Accordingly, for at least these reasons, Applicants respectfully request that the rejection be withdrawn.

IV. Double Patenting Rejection

The Office maintains the rejection of claims 1-24 and 79-107 on the ground of non-statutory obviousness-type double patenting as allegedly being "unpatentable" over claims 1-31 and 73-100 of co-pending U.S. Patent Application No. 10/654,887. Office Action, page 15.

While Applicants disagree, solely to expedite prosecution, Applicants file a Terminal Disclaimer herewith against U.S. Patent Application No. 10/654,887. Accordingly, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the application and the timely allowance of the pending claims.

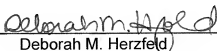
If the Examiner believes a phone call would be useful in resolving the outstanding issues, the Examiner is respectfully invited to contact the undersigned at 202-408-4368.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 10, 2009

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Attachment:

Terminal Disclaimer over copending U.S. Patent Application No. 10/654,887